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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/378,318    08/20/99    TREADWAY

G    35294.3.5

EXAMINER
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IM52/0627

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ART UNIT	PAPER NUMBER

1713  
DATE MAILED:

06/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/378,318

Applicant(s)

TREADWAY, GERALD D.

Examiner

Peter D. Mulcahy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 August 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

Applicants should note that the claims as presented were numbered incorrectly. There are two claim No. 11's and as such, the second claim 11 has been renumbered as 12. Claims 12-17 as originally presented have now been renumbered to be claims 13-18.

Claims 1-18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Applicants' claims are indefinite in that the recitation of "the hydrolysis product of an epoxy functional alkoxysilane" and "unhydrolyzed epoxy functional alkoxysilane" are seen to be overlapping in scope. It should be understood that the notion of hydrolysis is not one of being either hydrolyzed or unhydrolyzed but rather a degree dependent limitation. This is to say that partially hydrolyzed epoxy functional akoxysilanes are routinely incorporated in such compositions and commercially available. It is seen that a partially hydrolyzed resin would both read on the unhydrolyzed compound as well as the hydrolyzed compound. As such, the claims remain indefinite.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that

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the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Funaki et al., U.S. Patent 4,642,266.

The Funaki patent teaches coating compositions which incorporate partial hydrolyzates of epoxy containing organic silane compounds. See component (A). This is seen to read on applicants' instantly claimed hydrolyzed compound as well as unhydrolyzed compound.

The curing agents are shown at column 8 lines 12+.

The surface active agents are shown at column 9 lines 15+.

The instantly claimed ethylenically unsaturated monomers are shown extensively at column 12 lines 63+. The Examiner maintains that it would be prima facie obvious to formulate applicants' instantly claimed composition from this disclosure since each of applicants' ingredients is shown and suggested to be utilized in combination.

Claims 1-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Morrison, U.S. Patent 5,314,980 or Tarshiani et al., U.S. Patent 5,385,955 taken in view of Perkins et al., U.S. Patent 5,221,560.

The Morrison and Tarshiani et al. patents are cited as showing epoxysilane coating compositions which have incorporated

therein applicants' instantly claimed surfactants and curing agents. The notion of combining the hydrolyzed compound with the unhydrolyzed compound is seen to be rendered prima facie obvious by the disclosure of the partial hydrolysis products as well as the "and/or" language utilized in describing the incorporation of these ingredients. See specifically Tarshiani et al. at columns 3 and 4 as well as Morrison at column 3 lines 60+. These patents are seen to show each of the claimed ingredients but for the ethylenically unsaturated monomer as instantly claimed. The Perkins et al. patent also shows epoxysilane coating compositions which have incorporated therein the instantly claimed curing agents as well. This patent is specific as to the desirability of the incorporation of monofunctional monomers. See the Abstract as identified as (e). The Examiner maintains that it would be prima facie obvious to incorporate the monofunctional monomers into the compositions of Morrison and Tarshiani et al. given the art recognized function of these compounds and the attendant function associated therewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy, whose telephone number is (703) 308-2449. The examiner can normally be reached on Tuesday through Friday from 7:30 A.M. to 6:00 P.M.

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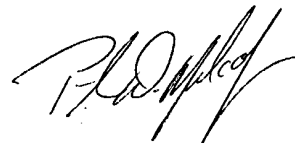
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The fax telephone number for this group is (703) 305-3599.

Any inquiry of general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2351.

P. Mulcahy:cdc  
June 26, 2001



**PETER D. MULCAHY  
PRIMARY EXAMINER  
GROUP 1500**